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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David S. Gress

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EXAMINER

DINH, KHANH Q

ART UNIT

PAPER NUMBER

2151

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/633,899

Applicant(s)

GRESS ET AL.

Examiner

Khanh Dinh

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the Amendment filed on 1/17/2007. Claims 1-34 and new claims 35-38 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter (the term "non generic voice message" in independent claims 1, 12, 18 and 29) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of 35 U.S.C. 102(e) which forms the basis for all obviousness rejections set forth in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 5, 9-13, 15, 18-19, 22, 26, 26- 29, 31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Albal et al. (hereafter Albal), US 2003/0147518 A1.

As to claim 1, Albal discloses a method in an application server for playing a messaging prompt of a called party (subscriber) to a calling party, the method comprising:

- receiving calling party number information specifying a calling party (see abstract, fig.2, [0022] to [0023]);

- accessing stored calling party number information from an Internet Protocol (IP) based database server (using Communication node 56 fig.2 and a server for serving caller's requests including IP requests) configured for storing calling party number information (see [0025] to [0028] and [0077] to [0080]);

- comparing the received calling party number information to the stored calling party number information to determine if there is a match between the received calling party information number and the stored calling party number information (verifying the caller's number, see fig.4, [0029] to [0030]);

based on a determined match of the stored calling party number information identifying the calling party as a matched calling party (finding a match between the caller's telephone number and a stored number in the subscriber's contact list, see [0025] to [0026]), retrieving a personalized, non generic voice message having a recorded voice of the called party (subscriber) (the subscriber can instruct the communication node to play a pre-record message or announcement or disconnect the call or indicating to the caller that the subscriber is unavailable, see [0031] to [0033]), corresponding to the matched, stored calling party number information, for playback the message prompt to the calling party (automatically identifying the user and providing a personal greetings to the user, see [0040] and [0046] to [0050]).

As to claim 2, Albal discloses the received and stored calling party number information each includes at least a portion of a telephone number of the calling party (see [0036] to [0040] and [0074]).

As to claim 5, Albal discloses retrieving the stored personalized voice message from the IP based database server (see [0077] to [0081]).

As to claims 9 and 10, Albal discloses corresponding a flag to certain of the stored calling party number information, the flag indicating a calling feature defined by a called party for use by the calling party one of a paging operation and a single number reach operation (see fig.9, [0041] to [0046] and [0048]).

As to claim 11, Albal discloses receiving a dialed number identification string (DNIS), and wherein the accessing step includes accessing a subscribers' profile based on the DNIS, the subscriber's profile including the stored calling party number information and the corresponding personalized voice message (see [0050] to [0056] and [0069] to [0073]).

As to claim 12, Albal discloses a messaging system for playing a message of a called party (subscriber) to a calling party in response to a request for execution of a messaging operation, the request containing calling party number information, the messaging system including:

an application runtime environment configured for retrieving, for playback the messaging prompt as the messaging prompt to the calling party (see fig.2, abstract, (see [0025] to [0028]), a personalized, non generic voice message having a recorded voice of the called party (subscriber) (the subscriber can instruct the communication node to play a pre-record message or announcement or disconnect the call or indicating to the caller that the subscriber is unavailable, see [0031] to [0033]), based on a match of the received calling party number information with calling party number information stored in an Internet Protocol (IP) based database server (verifying the caller's number, see fig.4, [0029] to [0030]), the match identifying a matched calling party (finding a match between the caller's telephone number and a stored number in the subscriber's contact list, see [0025] to [0026]) the personalized voice message corresponding to the

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matched and stored calling number information of the calling party (automatically identifying the user and providing a personal greetings to the user, see [0040] and [0046] to [0050]).

Claims 13 and 15 are rejected for the same reasons set forth in claims 11 and 3 respectively.

Claims 18, 19, 22, 26-28 are rejected for the same reasons set forth in claims 1, 2, 5, 9-11 respectively.

Claims 29, 31 and 34 are rejected for the same reasons set forth in claims 12, 15 and 13 respectively.

As to claims 35-38, Albal discloses the personalized voice message contains information specifically for matched calling party (see [0022] to [0026]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were

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made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 4, 14, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal in view of Ng et al., US pat. No.6,243,376.

Albal's teachings still applied as in item 6 above. Albal does not specifically disclose using accessing message using LDAP protocol. However, LDAP protocol is generally well known in network standards art as disclosed by Ng (see abstract, col.7 lines 20-64). It would have obvious to one of the ordinary skill in the art at the time the invention was made to utilize LDAP protocol in the computer system of Albal to process calling information because it would have provided a standard way for Internet clients or applications and servers to access directories services and locate organizations, organization units or individuals (see Ng's col.7 lines 39-47).

8. Claims 3, 6-8, 16, 17, 21, 23-25, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal and Ng as in item 7 above and further in view of Bobo, II, US pat. No.5,870,549.

Claims 3 and 6-8 are rejected for the same reasons set forth in item 7 above. Neither Albal nor Ng specifically discloses receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag

including a .wav file and a second media tag configured for controlling playing of the .wav file. However, Bobo discloses receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a .wav file and a second media tag configured for controlling playing of the .wav file (see abstract, figs.1, 2, col.7 line 28 to col.8 line 46 and col.13 line 13 to col.14 line 55). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Bobo's teachings into the computer system of Albal for generating and executing web applications because it would have enabled users to deploy a scalable, open standards based form approval system on an open standards based Internet Protocol network using a telephone.

Claims 16 and 17 are rejected for the same reasons set forth in claims 7 and 8 respectively.

Claims 21, 23-25 are rejected for the same reasons set forth in claims 3, 6-8 respectively.

Claims 32 and 33 are rejected for the same reasons set forth in claims 16 and 17 respectively.

Response to Arguments

9. Applicant's arguments filed on 1/17/2007 have been fully considered but they are not persuasive.

- Applicant asserts that the cited reference does not disclose a “personalized, non generic voice message”.

Examiner respectfully disagrees. Examiner respectfully point out that Albal clearly discloses a “personalized, non generic voice message” (for example, the subscriber can instruct the communication node to play a pre-record message or announcement or disconnect the call or indicating to the caller that the subscriber is unavailable, see [0031] to [0033]) as rejected above.

- Applicant asserts that the term “personalized” voice message is not as described as in page 11 of the specification of the instant application.

Examiner respectfully point out that claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. See In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978). The Examiner has a duty and responsibility to the public and to Applicant to interpret the claims as broadly as reasonably possible during prosecution (see In re Prater, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969)).

As a result, cited prior art does disclose a method in an application server for playing a messaging prompt of a called party to a calling party, as broadly claimed by the Applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior art.

Conclusion

10. Claims 1-38 are *rejected*.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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